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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/244,374	02/04/1999	DAVID L. HOLLIDAY	1575.001	3677

7590 07/18/2006
B CRAIG KILLOUGH
134 MEETING STREET
SUITE 300 P O DRAWER H
CHARLESTON, SC 29401

EXAMINER

HALE, GLORIA M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 07/18/2006

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/244,374

Applicant(s)

HOLLIDAY, DAVID L.

Examiner

Gloria Hale

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2001 and 14 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Reissue Applications

Claims 11-22 are rejected under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472,46 USPQ2d 141 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464,45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v United States*, 729 F. 2d 1429,1436, 221 USPQ 289,295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the filing of the present reissue application.

In MPEP section 1412.02,(I) Three Step Test For Recapture, if applicant argues subject matter that defines the application over the prior art, what is covered by the argument in the original application cannot be removed from the proposed Reissue claims. In this case, applicant argued in the parent application 08/617,507,paper 3A , page 4 under 35 U.S.C. 103 that none of the references disclose a uniform soft rubberized foam interior, as disclosed and claimed. Henceforth, this limitation included in claim 1 of the Patent was critical and depended upon for allowance of the claim over

the prior art. Under Section 1. The Two Sub-Steps, it states "If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the prior art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art." Applicant's arguments effectively constitute surrender of the claimed subject matter that cannot be recaptured via reissue.

Furthermore, in MPEP Section 1412.02 section labeled. Comparison of Reissue claims Narrowed/Broadened Vis-à-vis the Canceled Claims, it states that "DEFINITION: "Canceled claims"" in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims (A) can simply be canceled and not replaced by others, or (B) can be canceled and replaced by other claims which are more specific than the canceled claims in at least one aspect (to thereby define over the art of record). The "replacement claims" can be new claims which are narrower than the canceled version of the claims. The Recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (A) of the same scope as, or (B) broader in scope than, those claims canceled from the original application to obtain a patent. (In re Ball Corp. v. United States, 729 F. 2d at 1436, 221 USPQ at 295). This claim appears to be broader in scope than those claims canceled in the original application. Accordingly claims 11-22 must include

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therein, the same uniform soft rubberized foam interior limitation as that of claim 1 because it was relied upon, in arguments by the applicant, for patentability over the prior art of record.

Also, with respect to claim 11, the omission of the phrase "and front torso" in the claim invokes recapture because this limitation was added to claim 1 in the original application (see paper 3A as cited above) to make the claim allowable. Since this "surrender generating" language was added to claim 1 to make the claim allowable, applicant cannot present a claim in a reissue application without this limitation present. (See arguments above under Section 1, The Two Sub-Steps with respect to the removal of a limitation that was added to the claim to make the claim patentable.)

Claims 11-21 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

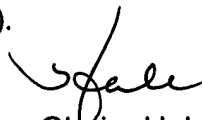
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Tues.-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 571-272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gloria Hale
Primary Examiner
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